

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Application No. 09/376,880
Attorney Docket No. A8135

II. Formal Matters

A. Priority

The Examiner failed to acknowledge Applicants' claim for domestic priority under 35 U.S.C. § 119(e) from U.S. Provisional Application No. 60/107,395. Consequently, Applicants again respectfully request that the Examiner acknowledge Applicants' claim on the record.

B. Information Disclosure Statement

The Examiner failed to provide a signed and initialed copy of the IDS filed on September 14, 1999, thereby indicating consideration of the reference cited therein. Consequently, Applicants again respectfully request that the Examiner provide such a copy on or before the date of the next Action.

C. Drawings

Applicants resubmitted (4 sheets of) formal drawings along with a copy of the original transmittal sheet and the OIPE-stamped receipt on August 28, 2002. Accordingly, Applicants respectfully request that the Examiner indicate acceptance of these resubmitted drawings on the record.

D. Form PTO-892

Applicants noted errors on lines C, D, E, and G with respect to the listed classifications on the Form PTO-892 provided with the Office Action dated June 5, 2002. Consequently, Applicants again respectfully request that the Examiner provide a corrected Form PTO-892 on or before the date of the next Action.

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III. Claim Rejections

Claims 1-6, 10-15, and 19-24 stand rejected under § 102(b) as allegedly being anticipated by Raman. Additionally, claims 7-9, 16-18, and 25-33 stand rejected under § 103(a) as allegedly being unpatentable over Raman, in view of Guck. Applicants traverse the rejection of claims 1-33 as follows.

A. Claims 1, 10, and 19

Applicants traverse the rejection of independent claims 1, 10, and 19 because Raman fails to disclose each and every feature recited therein. For example and not by way of limitation, claims 1, 10, and 19 each recite "returning a locator to the client computer for locating the converted data". Conversely, Raman discloses that the actual converted data is transmitted over the network to the client system. *See, e.g.*, Fig. 1b, element 18; col. 3, lines 8-13 of Raman. Returning the actual converted data does not correspond to "returning a locator to the client computer for locating the converted data". Thus, Raman fails to disclose the recited feature of "returning a locator to the client computer for locating the converted data", as recited in claims 1, 10, and 19.

The Examiner alleges that the feature of "returning a locator to the client computer for locating the converted data" is vague and does not show the novelty of the claimed invention (*see* Office Action, page 6). Applicants respectfully disagree with the Examiner's allegations. One of ordinary skill in the art would, from the language of the claim itself, know that a locator is used by the client "for locating the converted data". Thus, for example, the locator can be a URL (Universal Resource Locator), as the Examiner appears to note below. Additionally,

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Applicants' disclosure is replete with illustrative, non-limiting examples that would be fully understood by one of ordinary skill in the art so as to contradict the Examiner's allegation of vagueness. *See, e.g.*, Applicant's Fig. 4; page 2, lines 19-25; page 7, lines 8-16; and page 10, lines 20-24. Additionally, the Examiner's allegation as to showing the novelty of the claimed invention misses the point. The Examiner fails to satisfy his burden (*see, e.g.*, MPEP § 2131) of establishing that claims 1, 10, and 19 are anticipated by Raman, because Raman fails to disclose each and every feature of the claimed invention, *e.g.*, the feature of "returning a locator to the client computer for locating the converted data".

Furthermore, the Examiner alleges that "Raman further teaches locator URL is returning (sic: returned) to the client with the data" at Figs. 7a and 7b of Raman. Applicants note that the message of Fig. 7a is being sent to a parsing server. Furthermore, the (response) message of Fig. 7b contains the URL of the resource which was parsed (*see col. 6, lines 30-47 of Raman*), which does not correspond to "returning a locator to the client computer for locating the converted data". To the contrary, the (response) message of Fig. 7b returns the actual parsed data to the client, such that a locator to the converted data is unnecessary.

B. Claims 2-6, 11-15, and 20-24

Applicants traverse the rejections of claims 2-6, 11-15, and 20-24 at least by virtue of their dependency.

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C. Claims 7-9, 16-18, and 25-27

Applicants traverse the rejections of claims 7-9, 16-18, and 25-33 because the combination of Raman and Guck fails to teach or suggest all of the features recited therein. Claims 7-9, 16-18, and 25-33 respectively depend from claims 1, 10, and 19. As discussed above, Raman fails to disclose the feature of "returning a locator to the client computer for locating the converted data", as recited in claims 1, 10, and 19.

Furthermore, Guck fails to make up for this deficiency of Raman because Guck fails to teach or suggest the feature of "returning a locator to the client computer for locating the converted data", as recited in claims 1, 10, and 19. To the contrary, Guck discloses that when a client requests data from a shadow file, the shadow file fetches the contents of its source file, calls on its converter to convert the contents of the source file into an output content, and returns the transformed output content back to the requesting client. *See, e.g.*, col. 16, lines 45-60 of Guck. Returning the actual converted data is not the same as "returning a locator to the client computer for locating the converted data".

Thus, the combination of Raman and Guck fails to disclose, teach, or suggest all of the features recited in claims 1, 10, and 19 so as to establish a *prima facie* case of obviousness. Therefore, claims 7-9, 16-18, and 25-27 are patentable over the combination of Raman and Guck at least by virtue of their dependency.


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IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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